No. 93-181

In The

Supreme Court of the United States

October Term, 1993

SHORTY, INC.,

Petitioner,

v.

Q.G. PRODUCTS AND G.L. GROUP, LTD.,

Respondents.

Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

ALLEN D. BRUFSKY
KRAMER, BRUFSKY & CIFELLI, P.C.
181 Old Post Road
P.O. Box 59
Southport, Connecticut 06490
(203) 255-8900
Attorneys for Respondents

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

BEST AVAILABLE COPY

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES ii

STATEMENT OF THE CASE 1

SUMMARY OF ARGUMENT FOR DENIAL OF PETITION 7

ARGUMENT 8

I. THE DECISION OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT DOES NOT CONFLICT WITH THE DECISIONS OF THIS COURT IN *WESTINGHOUSE v. FORMICA*, 266 U.S. 342 (1924); *SCOTT PAPER v. MARCALUS*, 326 U.S. 249 (1945); AND *LEAR v. ADKINS*, 395 U.S. 653 (1969) 8

II. THE COURT OF APPEALS' DECISIONS AND THOSE OF THE DISTRICT COURT HAVE RECOGNIZED THE DOCTRINE OF ASSIGNOR ESTOPPEL LIMITED BY BALANCING OF THE EQUITIES AND POLICY CONSIDERATIONS INVOLVED IN THE PARTICULAR CASE 12

III. THE BALANCE OF THE EQUITIES AND POLICY CONSIDERATIONS IN THIS PARTICULAR CASE SUPPORT THE APPLICATION OF ASSIGNOR ESTOPPEL 14

IV. THERE WERE NO GENUINE ISSUES OF MATERIAL FACT TO PRECLUDE THE GRANT OF SUMMARY JUDGMENT 16

CONCLUSION 18

TABLE OF AUTHORITIES

Page

CASES

American Fence Co., Inc. v. MRM Security Inc., 710 F.Supp. 37, (D. Conn. 1989) 12

Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986) 17

Diamond Scientific Co. v. Ambico, Inc., 848 F.2d 1220 (Fed. Cir. 1988), *cert. dismissed*, 487 U.S. 1265 (1988) 12, 13, 14

Lear, Inc. v. Adkins, 395 U.S. 653 (1969) 8, 10

Palumbo v. Don-Joy Co., 762 F.2d 969 (Fed. Cir. 1985) 17

Scott Paper Co. v. Marcalus Mfg. Co., Inc., 326 U.S. 249 (1945) 7, 8, 9, 11

Shamrock Technologies Inc. v. Medical Sterilization Inc., 903 F.2d 789 (Fed. Cir. 1990) 13

Specialty Composites v. Cabot Corp., 845 F.2d 981 (Fed. Cir. 1988) 17

Westinghouse Electric & Mfg. Co. v. Formica Insulation Co., 266 U.S. 342 (1924) 7, 8, 9, 11

STATUTES AND RULES

35 U.S.C. § 102(f) 6

Fed. R. Civ. P. 56(c) 1, 17

STATEMENT OF THE CASE

Shorty, Inc. (hereinafter "Shorty") has brought a petition for a writ of certiorari asking this Court to review the judgment of the United States Court of Appeals for the Federal Circuit which held it infringed United States Patent No. 4,989,438 ('438 patent) and applied the doctrine of assignor estoppel to bar Shorty's patent invalidity defense.

Shorty claims that the application of the doctrine of assignor estoppel by the Court of Appeals expanded the doctrine to a situation where defendant never owned the '438 patent and as a consequence there was no privity between Shorty and the present assignee, the Respondent, G.L. Group, Ltd. (hereinafter G.L.). Q.G. Products, Inc. (hereinafter Q.G.) is the exclusive licensee of G.L. Group, Ltd. and has joined with G.L. in the action seeking enforcement of the patent.

However, what Shorty overlooks, and as held by both the District Court and the Court of Appeals, is that Shorty had title to the invention disclosed in the '438 patent as defined by the claims which ultimately issued in the '438 patent, and therefore could not be heard to complain that it was barred from asserting invalidity under the doctrine of assignor estoppel. The District Court and the Court of Appeals also held that there were no genuine disputes regarding any issue of material fact concerning the assignment of the invention between Shorty and respondent's predecessor in title, and therefore granting of summary judgment was proper under Fed. R. Civ. P. 56(c).

In 1987, Guy Lallier, Marc Lallier, and Rudolphe Simon discussed a design for a device for fastening metal corner strips to wall boards to join the wall boards prior to their coating with an adhesive compound. In February 1988, Simon filed patent application No. 07/157,377 ('377) for such a device. The '377 application disclosed a device that holds a metal corner strip in place while mechanically fastening it (by crimping) to the ends of two wall boards. A "shoe" on the device holds the protective strip in alignment during fastening.

The '377 application depicted a corner strip and a shoe. The application made no mention of interchangeable shoes for holding different contoured strips, although the shoe depicted was removable. Claim 1 of the application also described "power operated means" for driving crimping elements into the strip to fasten the strip to the wallboard corner. Narrower claims specifically mentioned a motor and a solenoid, as one example of such "power operated means."

Also in February 1988, the Lalliers and Simon agreed to form Shorty, Inc. to exploit the invention of the '377 application. Simon assigned his right to the '377 application to Shorty for a $20,000 loan and stock in the company. The Lalliers contributed money to the corporation. The parties executed a written contract reflecting this agreement on April 2, 1988.

Due to a falling-out between Simon and the Lalliers, Shorty reassigned the '377 application to Simon in July 1988 in exchange for $3,000, a promise for $17,000 more,

and return of the Shorty stock.[1] At the time of the assignment in July 1988, Shorty implicitly represented to Simon that the invention in the '377 application had some value. For the assignment, Shorty received $3,000, stock, and a promise for $17,000 more.

On April 24, 1988, a Patent and Trademark Office examiner rejected all of the '377 claims. Although the examiner initially rejected all the claims of the '377 application in April 1988, this rejection did not render the application valueless. Such rejections often occur as part of the normal application process. Although Shorty's assignment merely returned the parties to their pre-incorporation financial posture, Shorty nevertheless received value for the assignment. Thus, Shorty represented that the assigned property had value.

---

[1] If the '438 patent which ultimately issued and forms the basis of the infringement suit, claimed an invention within the scope of the assignment agreement, there would be no dispute that the assignor estoppel doctrine operates to prevent Shorty from contesting the validity of the patent, as there would be privity between Shorty and the respondents. The assignment agreement provided that "Simon is the inventor of a drywall corner bead clincher, also known as a Power Actuated Device for Installing Metal Corner Strip, upon which application No. 157,377 is pending before the U.S. Patent Office." Under the agreement, Shorty "waive[d] any claim *to said invention* or contracts relating thereto, and reassign[ed] *its rights thereto* to Simon, and agree[d] that neither it nor any of its remaining principals shall have any interest henceforth in said invention." *This assignment of the invention is G.L. and Q.G.'s basis for assignor estoppel.* (emphasis added.)

Simon filed one amendment and then abandoned the '377 application in December 1989. In October 1989, however, Simon had already filed a continuation-in-part application,[2] No. 07/423,950 ('950), of the '377 application. The '950 application claimed the same device, but added an interchangeable shoe feature,[3] *pneumatic* power

---

[2] A continuation-in-part application is an application which is filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application and adding matter not disclosed in the earlier application. The common subject matter is entitled to the filing date of the earlier application.

[3] The '438 patent claims a device comprising "a plurality of interchangeable shoes" and "means for releasably mounting each of said shoes on the device." The '377 application did not claim a releasable mount for interchangeable shoes, but disclosed one. Nevertheless, during prosecution of the '950 application, (which matured into the '438 patent) the examiner determined that "the skilled artisan within this art is quite cognizant of the concept of constructing tools with replaceable parts on the hand tools . . . [t]his is a commonly known practice." The examiner found that this aspect of the invention in the '950 application was obvious in light of the prior art. Thus, as held by the Court of Appeals shoe interchangeability was not a material difference between what Shorty assigned and the '438 patent.

Simon also testified that he demonstrated a prototype with interchangeable shoes to the Lalliers before the assignment. Simon testified that he first developed the ability to interchange shoes in early 1985, more than two years before Shorty reassigned the invention to Simon. Because Simon assigned all his rights to the invention to Shorty – including shoe interchangeability – it was held that Shorty necessarily assigned those rights back to Simon.

means,[4] and a pistol grip.[5] The interchangeable shoe allows the operator to switch shoe contours or sizes for

---

[4] The '438 patent also discloses use of pneumatic power means for actuating the device. While not specifically disclosing pneumatic powering, the '377 application claimed power operated means in claim 1. More important, dependent claim 2 in the '377 application recited the use of a general motor in sweeping terms:

> 2. A device as set forth in claim 1 wherein said power operated means comprises a motor having a fixed part mounted in fixed position relative to said retaining means and a reciprocally movable part connected to said operating means.

The language of this claim could cover a motor using electric power, such as the solenoid disclosed in the application, or pneumatic power, or even hydraulic power. The language in both claims 1 and 2, as held by the Court of Appeals, show that the interchangeable shoe and pneumatic power features were encompassed within the invention of the '377 application which Shorty assigned for value.

[5] The prosecution history reveals that the examiner allowed the application because Simon later claimed a transversely mounted pistol grip, not because of more specific language about interchangeable shoes or power operating means. The examiner's interview summary record, indicating that an agreement had been reached, stated that the agreed-to claims would "clearly defin[e] the mounting (i.e., operable connection) attaching means to the shoe and . . . relat[e] the pistol grip and shaft relative to one another and the housing rather than relative to the horizontal. As agreed, the claims define over the art . . . " Before this agreement, Simon made several unsuccessful amendments concerning the interchangeable shoe feature and the power operated means. Thus, as held by the Court of Appeals, the prosecution history shows that the examiner allowed the claims after insertion of language on the transversely mounted pistol grip.

The pistol grip depicted in the '950 application, however, is virtually identical to that shown in the '377 application. Simon

different corner angles (e.g., 90 degrees, 135 degrees, etc.). The '950 application matured into the '438 patent.

Shorty asserted that it did not assign the *invention* in question. That is, Shorty assigned the '377 application, not the '950 application which later matured into the '438 patent. Because the '950 application was a continuation-in-part of the '377 application, Shorty contends that the differences between the two applications precludes the application of the doctrine of assignor estoppel in that there is no privity between Shorty and the owner of the '438 patent, G.L. and indeed, Shorty never owned the *patent* in suit. But, Shorty has missed the point. It had assigned the *invention* of the '377 application, and not only the application, which *is* embraced within the claims of the '438 patent, (see n. 3, 4 and 5, *supra*), as held by the Court of Appeals.

Simon assigned his interest in the invention and the '950 application to Nastasi-White, Inc., who in turn assigned the application to the plaintiff, G.L. G.L. (and its exclusive licensee Q.G.) then filed an infringement action against Shorty. Infringement was admitted, as the accused device and patented device, as embodied in the claims, were identical. However, as a defense, Shorty asserted that the '438 patent was invalid under 35 U.S.C. § 102(f). Shorty claimed that Guy Lallier worked with Simon on the invention and thus should have been listed as a co-inventor. G.L. moved for summary judgment

---

carried this inventive aspect from the '377 application over to the '950 application. In all, the prosecution history shows that the '438 patent merely elaborates on the *invention* Shorty reassigned to Simon.

asserting that assignor estoppel barred Shorty's invalidity defense. The magistrate judge recommended that the district court grant G.L.'s summary judgment motion. The district court followed that recommendation, which was affirmed by the Court of Appeals.

SUMMARY OF ARGUMENT FOR DENIAL OF PETITION

1. The invention of the '438 patent asserted against Shorty embraces the invention assigned by Shorty back to Simon, who then assigned his rights (via a mesne assignment) to G.L.

2. Since the '438 patent embraces the invention assigned by Shorty, the patent owner G.L. and Shorty are in privity, as Shorty owned the invention subsequently assigned to the patent owner.

3. To prevent unfairness and lend credence to the contract between the parties, an assignor of a patent cannot benefit from asserting that the patent is invalid, when sued by the assignee or one in privity therewith, having already received the benefit of the contract, except where there is a paramount public interest involved, such as the patented device is in the public domain free for anyone to use.

4. This doctrine is well established in the decisions of this Court, as exemplified by *Westinghouse Electric & Mfg. v. Formica Insulation Co.*, 266 U.S. 342 (1924), and *Scott Paper Co. v. Marcalus Mfg. Co., Inc.*, 326 U.S. 249 (1945).

5. There is no genuine issue of material fact that petitioner Shorty assigned an invention to the predecessor in title of the patent owner; that that invention is embraced within the scope of the '438 patent asserted against Shorty, and that Shorty's defense does not fall within the exception to the application of the assignor estoppel rule.

6. This case, therefore, does not raise any unusual questions of law which have not been settled by this Court.

ARGUMENT

I. THE DECISION OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT DOES NOT CONFLICT WITH THE DECISIONS OF THIS COURT IN *WESTINGHOUSE V. FORMICA*, 266 U.S. 342 (1924); *SCOTT PAPER V. MARCALUS* 326 U.S. 249 (1945); AND *LEAR V. ADKINS*, 395 U.S. 653 (1969).

The law in the area of assignor estoppel, as pronounced by this Court, is clear and well settled.

In the leading case of *Westinghouse Electric & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342 (1924), the Court gave credence to the doctrine of assignor estoppel in patent cases and held that where an *invention* along with an inchoate right to a patent therefore had been assigned before the granting of the patent, as is the case here, the assignee and those in privity with him are barred from raising an invalidity defense as a matter of contract law, where the assignor's original invention reasonably foreshadowed the ultimate claims which issued in the patent.

The basis of the rule is that it would be manifestly unfair for an assignor to attack as a nullity a piece of property for which he has received value. However, this equitable consideration must be balanced and yield to public policy considerations relating to patents – specifically, that the public should be free to use *un*patented devices, processes, and articles of manufacture within the public domain, which could also be raised by a third party sued by the assignee in a patent infringement suit. Public policy considerations as to the nature of a patent grant mandated by the Constitution, i.e., that it is a limited monopoly given for a certain amount of years in return for public use at the expiration of the grant, or if not entitled to a patent, the invention is in the public domain, *ab initio* for which no grant should have been given, dictated some equitable limitation on the "blind" application of the doctrine of assignor estoppel.

Therefore, this Court has allowed an assignor charged with infringement to show the state of the prior art when sued for infringement which may be used to construe and narrow the claims of the patent for the invention grant, conceding their validity. *Westinghouse, supra* at 351. The purpose of the exception to the assignor estoppel rule was twofold: (1) to place the assignor on the same footing as to defenses which would be applicable between the assignee and a *stranger*; and (2) to effectuate public policy that the public should have the right to use any and all inventions which are in the public domain.

In *Scott Paper Co. v. Marcalus Mfg. Co., Inc.*, 326 U.S. 249 (1945), the application of the doctrine of assignor estoppel was further limited by this Court to permit the assignor to raise the invalidity of the patent where the

claimed invention was *exactly* shown in an expired patent. Once again, the Court held that the public policy of the patent laws requiring dedication to public use of an invention of an expired patent was paramount and superseded any contract right foreclosing the assignor from rendering as a nullity the right assigned for which he received value.

In *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969) the *licensee* of a patent was permitted to raise as a defense the invalidity of the patent, when sued by his licensor, after repudiation of the license agreement and cessation of the payment of royalties to the licensor. Once again, the Court gave credence to the overriding public policy consideration that the public should be freed of invalid patents and be permitted to use those inventions in the public domain, even to the extent of enabling a licensee to abrogate the contract which was fairly negotiated for value. But, a license is a contract which can be repudiated. The duty to pay royalties is an ongoing obligation. An assignment of a patent, on the other hand, is a complete, one-time transaction which once accomplished, cannot be defeated. Unlike the licensee, who without the rule of *Lear* might be forced to continue to pay for a potentially invalid patent, the assignor who would challenge the patent has already been paid for the patent rights. The assignee has the right to rely on his purchase for value.

Therefore, the doctrine of assignor estoppel (which is different in scope than licensee estoppel) is clearly the law of the land with two exceptions where public policy considerations require that the assignor be free to contest the validity of the patent: (1) where the patent would be

invalid unless the claims are construed to avoid the prior art; and (2) where the alleged invention of the patent is illustrated in an expired patent and is in the public domain. These situations are narrowly limited to those where the alleged invention of the patent is in the prior art and free for anyone to use.

Other than in these two situations, the Court has been consistent in looking at the equities that determine whether the assigned property had value and whether the contract of assignment for which the assignor received value and bargained for was *fairly* negotiated. *Westinghouse* and *Scott Paper, supra*. The principle of fair dealing as between assignor and assignee of a patent whereby the assignor will not be allowed to say that what he has sold as a patent was not a patent has been part of the fabric of our law throughout the life of this nation, *Scott Paper* at 260 (dissenting opinion), and thus the assignor as a matter of law should not be permitted to readily abrogate the negotiated contract.

The Courts of Appeals and particularly the Court of Appeals for the Federal Circuit which deals with the patent issues, has consistently applied these principles in their decisions, as it did in this case, to determine whether the assignor should be precluded from raising an invalidity defense under 35 U.S.C. § 102(f) that the inventor of the '438 patent did not himself invent the subject matter sought to be patented, but that one of the assignor's principals was a co-inventor. There was ample opportunity to correct this situation at the time the assignor, Shorty, owned the invention and the '377 application.

II. THE COURT OF APPEALS' DECISIONS AND THOSE OF THE DISTRICT COURT HAVE RECOGNIZED THE DOCTRINE OF ASSIGNOR ESTOPPEL LIMITED BY BALANCING OF THE EQUITIES AND POLICY CONSIDERATIONS INVOLVED IN THE PARTICULAR CASE.

The Court of Appeals for the Federal Circuit has had a number of occasions to apply the doctrine of assignor estoppel. In first recognizing the doctrine in *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220 (Fed. Cir. 1988), *cert. dismissed*, 487 U.S. 1265 (1988), the court held that assignment of a patent or an invention and a patent application for value estops the assignor from later contending that the assigned property was valueless. To prevent unfairness, the court refused to allow the assignor of a patent to benefit from an assignment, only to benefit again from asserting the patent's invalidity. The plaintiff Diamond Scientific had filed suit for patent infringement against defendant Ambico and a Dr. Wetter, claiming infringement of three patents, embodied in the applications *and inventions* for which Dr. Wetter had assigned, for valuable consideration, all his right, title and interest to plaintiff. The Court also noted that the assignor could present evidence of prior art to narrow the scope of the claims, possibly avoiding infringement. *Id.* at 1226.

In *American Fence Co., Inc. v. MRM Security Inc.*, 710 F.Supp. 37, (D. Conn. 1989), defendant was president of a company called Man Barrier Corporation. While employed there defendant assigned to Man Barrier, for valuable consideration, his entire right, title and interest in any patent that might issue from several pending patent applications, which included a "Declaration and

Power of Attorney," signed by defendant, stating that he verily believed he was "the original, first and sole inventor or discoverer of said invention." Man Barrier in turn assigned its entire right, title and interest in said patents that issued to American Security Fence Corporation, for valuable consideration. After leaving Man Barrier, defendant participated in the formation of MRM Security Systems, Inc.

Plaintiff asserted that defendant (MRM) was infringing upon two patents allegedly owned by plaintiff. Defendant denied plaintiff's allegations and claimed that the patents were invalid.

The court in following *Diamond Scientific* held that assignor estoppel prevented the defendants from challenging the validity of the patents in issue. The court said, "when the inventor-assignor has signed the Oath, Power of Attorney and Petition, which attests to his belief in the validity of said patents, and has assigned the patent rights to another for valuable consideration, he should be estopped from defending patent infringement claims by proving that what he assigned was worthless." *Further, the court held that this right extended to subsequent assignees. Accord*: *Shamrock Technologies Inc. v. Medical Sterilization Inc.*, 903 F.2d 789 (Fed. Cir. 1990) [It matters *not* whether invalidity or inequitable conduct before the Patent Office is defined as the defense; whether the assignment took place *before* the patent was issued; *or whether the proper inventors are named in the application*; or any other technical defense relating to the validity of the application, per se; as all rights to the assignor's right to the *invention* and *its equivalents* and *the right to continue*

the use thereof are assigned, and *not* the application. (emphasis added)]

As stated in *Diamond Scientific, supra*, at 1226:

> "It is also irrelevant that, at the time of the assignment, [the inventor's] patent applications were still pending and the Patent office had not yet granted the patent. *What [the inventor] assigned were the rights to his inventions.* That Diamond may have later amended the claims in the application process (a very common occurrence in patent prosecutions), with or without [the inventor's] assistance, does not give appellants' argument against estoppel any greater force. Our concern must be the balance of the equities." (Emphasis added)

III. THE BALANCE OF THE EQUITIES AND POLICY CONSIDERATIONS IN THIS PARTICULAR CASE SUPPORT THE APPLICATION OF ASSIGNOR ESTOPPEL.

As in *Diamond Scientific*, the inventions in this case *as disclosed* in the assigned '377 application, were finally patented *in the claims* of the '438 patent, even though the claims were in a different form than that originally filed. (See n. 3, 4 and 5, pp. 4-5, *supra*), so there is privity between Shorty, which assigned the '377 application, and the owner of the '438 patent.

The Court of Appeals followed its mandate and first decided that the District Court was correct to apply the doctrine of assignor estoppel, which required a balancing of the equities and policy considerations presented by the case.

At the time of the assignment in July 1988, Shorty implicitly represented to Simon that the invention in the '377 application had some value. For the assignment, Shorty received $3,000, stock, and a promise for $17,000 more. Although the examiner initially rejected all the claims of the '377 application in April 1988, this rejection did not render the application valueless. (Such rejections often occur as part of the normal application process.) Although Shorty's assignment merely returned the parties to their pre-incorporation financial posture, Shorty nevertheless received value for the assignment. Thus, Shorty represented that the assigned property had value.

Shorty's invalidity contentions in the District Court tipped the equities in favor of applying assignor estoppel. Shorty's primary ground for asserting invalidity of the '438 patent in the court below was 35 U.S.C. § 102(f). Shorty answered the complaint by alleging that, *inter alia*, Simon should have listed Guy Lallier as a joint inventor in the '377 application. Shorty contended that Guy Lallier had invented the corner fastening device before November 1987. At the time Shorty reassigned the application to Simon in July 1988, the Lalliers (Shorty) knew that the February 1988 patent application did not list Guy Lallier as an inventor. Nonetheless, Shorty assigned its rights under the application to Simon for value. Thus, they acknowledged the value of the application with full knowledge of the potential issue under Section 102(f).

Thus, the Court of Appeals for the Federal Circuit carefully balanced the equities and policy considerations

in the case[6] and found that the invention assigned had value, and that the invalidity defenses were not based on the invention being in the public domain, but upon the dealings between the parties. The petitioner could have raised various objections to the patent during the dealings with respondents predecessor assignment, but chose not to; particularly, the issue of the fact that the Lalliers would be co-inventors of the subject matter of the patent. They did not and because of the fairness of dealing between the parties wherein something of value was assigned, Shorty should be precluded from raising any such defense of invalidity of the patent.

IV. THERE WERE NO GENUINE ISSUES OF MATERIAL FACT TO PRECLUDE THE GRANT OF SUMMARY JUDGMENT.

Everyone involved in this case agrees on the facts. Simon assigned and received back his *invention*. The documentation of this fact is not disputed. Infringement stood admitted.

What was disputed was the *scope* of the invention which was assigned. But, a detailed analysis by the Court of Appeals and the district court determined what the scope of the invention was *as a matter of law*, after considering the facts which were undisputed – namely, what was in the prior art, the claims of the patent, and the prosecution history of the patent.

---

[6] There was never any defense of invalidity based on the invention being in the public domain as part of the prior art.

Where there is no genuine issue of material fact in dispute, as here, the grant of summary judgment is appropriate. The standard for summary judgment under Fed. R. Civ. P. 56(c) provides that the mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment, the requirement is that there be no *genuine* issue of *material* fact. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986).

Summary judgment may be entered in a patent case when "a properly interpreted claim with an uncontested description of the accused device reflects the absence of a genuine issue of material fact." *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 973 (Fed. Cir. 1985).

To ascertain the scope of the claim and the true meaning of the claim language, the court must consider the language of the claim itself, the patent specifications, and the prosecution history of the patent. *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986 (Fed. Cir. 1988). Review of other claims in the same patent may also be useful. *Id.* If the language of a claim is not disputed, then the scope of the claim may be construed as a matter of law. *Palumbo*, 762 F.2d at 974.

This is precisely what the District Court and the Court of Appeals did to ascertain that the claimed invention of the '438 patent embraced the invention assigned by Shorty in the '377 application; the *fact* that an invention was assigned and the infringement of the claim was not in dispute.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari to review the decision of the United States Court of Appeals for the Federal Circuit in this matter should be denied.

Specifically, the law of assignor estoppel in patent cases is well developed and the circuits present no conflicts as to the application of the doctrine, which is applied on an equitable basis to the facts of individual cases. This case was not extraordinary and involved the appropriate application of the doctrine as promulgated by the Supreme Court.

Respectfully submitted,

ALLEN D. BRUFSKY
KRAMER, BRUFSKY & CIFELLI, P.C.
181 Old Post Road
P.O. Box 59
Southport, Connecticut 06490
(203) 255-8900

Attorney for Respondents
Q.G. PRODUCTS and
G.L. GROUP, LTD.[7]

---

[7] Q.G. Products and G.L. Group, Ltd. are not owned by any parent corporation and have no subsidiaries.